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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|-----------------------------|------------------------|
| 10/607,896 | 06/27/2003 | Jason Cahill | MSFT-2154/302766.1 | 7211 |
| 41505 7590 10/29/2007 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891 | | | EXAMINER DADA, BEEMNET W | |
| | | | ART UNIT 2135 | PAPER NUMBER |
| | | | MAIL DATE 10/29/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/607,896

Applicant(s)

CAHILL ET AL.

Examiner

Beemnet W. Dada

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-13,15-19 and 21-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,7,9,13,15,19 and 21 is/are rejected.
- 7) ☒ Claim(s) 4-6,10-12,16-18 and 22-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 18, 2007 has been entered. Claims 1, 7, 13 and 19 have been amended and claims 2, 8, 14 and 20 have been cancelled. Claims 1, 3-7, 9-13, 15-19 and 21-24 are pending.

Response to Arguments

2. Applicant's arguments filed September 18, 2007 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 7, 9, 13, 15, 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Disanto et al. US 6,856,686 B2 (hereinafter Disanto) in view of Garibay et al. US 2004/0249756 A1 (hereinafter Garibay).

Art Unit: 2135

5. As per claims 1, 7, 13 and 19, Disanto teaches a method for a recipient to receive an email having right management (RM) protected content therein, the protected content being encrypted and decrptable according to a content key (KID), the content key (KD), the method comprising:

receiving the email while connectively coupled to a network through which the email may be obtained [column 13, lines 29-51];

recognizing that the received email has the protected content therein [column 13, lines 37-51]; and

obtaining an encryption/decryption key for the protected content of the email from an RM server while still connectively coupled to the network and in response to receiving the email and recognizing the protected content therein, such obtaining being performed in an automatic manner [column 13, line 37 – column 14, line 29],

whereby said recognizing and obtaining are performed in a manner transparent to a recipient of the email and whereby the key is available to the recipient even when such recipient is not connectively coupled to the RM server by way of the network at a later time [column 13, line 37- column 14, line 29]. Disanto is silent on obtaining a license for the protected content.

Garibay teaches a method for a recipient to receive an email having a protected content including, obtaining a license for the protected content of the email from an RM server while still connectively coupled to a network and in response to receiving the email and recognizing the protected content therein, such obtaining being performed in an automatic manner [paragraph 0020], whereby said recognizing and obtaining are performed in a manner transparent to a recipient of the email and whereby the license is available to the recipient even when such recipient is not connectively coupled to the RM server by way of the network at a later time [paragraph 0020]. It would have been obvious to one having ordinary skill in the art at the time

Art Unit: 2135

of the invention to employ the teachings of Garibay within the system of Garibay in order to achieve the predictable result of providing license to a recipient of a protected content.

6. As per claims 3, 9, 15 and 21, Disanto further teaches the method wherein obtaining the license comprises, placing a representation of the received email with the protected content therein into a queue, retrieving the representation of the received email from the queue, and requesting the key for the protected content of the retrieved email from the RM server [column 13, line 37- column 14, line 29].

Allowable Subject Matter

7. Claims 4-6, 10-12, 16-18 and 22-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

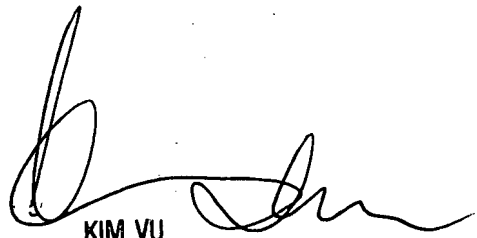
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Beemnet W Dada

October 23, 2007



KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100